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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,200	12/22/2003	Egidijus Edward Uzgiris	RD-26,797-6	4526
7590	03/31/2005		EXAMINER	JONES, DAMERON
General Electric Company CRD Patent Docket Rm 4A59 P.O. Box 8, Bldg. K1 Schenectady, NY 12301			ART UNIT	PAPER NUMBER
			1616	
DATE MAILED: 03/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/743,200	UZGIRIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	D. L. Jones	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 20 December 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 5-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 12/20/04 wherein the specification was amended; claims 1-4 were canceled; and claims 5, 7, 10, 22, and 27 were amended.

**Note:** Claims 5-27 are pending.

## **RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENT**

2. The Applicant's arguments filed 12/20/04 to the rejection of claims 5-27 made by the Examiner under 35 USC 103, 112, and/or double patenting rejection have been fully considered and deemed persuasive-in-part for the reasons set forth below.

### **112 Rejections**

The 112 rejections are WITHDRAWN because Applicant amended the claims to overcome the rejections.

### **Double Patenting Rejection**

The provisional rejection of claims 5-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-25 of copending Application No. 10/793,376.

It is duly noted that Applicant intends to file a terminal disclaimer at which time the claims are indicated as allowable.

### **103 Rejections**

The rejection of claims 5-27 over Sieving et al, Bioconjugate Chem., 1990, Vol. 1, No. 1, pages 65-71, is MAINTAINED for reasons of record in the office action mailed 11/30/04 and those set forth below.

In summary, Applicant asserts that the cited prior art differs from the instant invention in its molecular ratio. Specially, Sieving et al disclose a molar ratio of DTPA anhydride to lysine residues less than or equal to 4 while the instant invention is directed to a molar ratio of greater than or equal to 6. Also, it is noted that Applicant asserts that the temperature of Sieving et al is -30 degrees Celsius while the instant invention has been amended to state that the temperature is below -35 degrees Celsius.

It should be noted that molar proportions or ranges cannot be the basis for patentability of subject matter encompassed by the prior art where there is nothing to indicate that such proportion or range is critical. If criticality is asserted for proportions or ranges, the specification must not disclose them as merely preferred. Unless the allegations of the criticality of the limitations recited in the rejected claims are supported by actual proof, they cannot be given any weight in determination of the issue of obviousness. The limitation of *molar ratio and temperature* does not impart patentability to a process when such values are those which would be determined by one skilled in the art in achieving optimum operation of the process. Furthermore, it is noted that in Applicant's published application (US 2004/0136911), page 5, paragraph [0048], it is indicated that essentially similar results were obtained as those obtained when the ratio of DTPA anhydride to lysine in excess of 6. Also, it is noted that the general method set

forth on page 5, paragraph [0047] does not disclose a specific anhydride to lysine ratio. Hence, absent unexpected or unobvious results, a skilled practitioner would expect the prior art's method and Applicant's methods to yield essentially the same results.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones  
Primary Examiner  
Art Unit 1616

March 21, 2005